

**REMARKS**

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-12 were originally presented for consideration in this application. Claims 13-20 have been added by the foregoing amendment to afford the applicant the breadth and scope of patent protection to which he is entitled. Accordingly, claims 1-20 are currently pending in this application.

The following rejections, objections, and requirements were set forth in the Office Action:

1. Claim 5 is objected to under 37 CFR §1.75(c) as being in improper form;
2. Claims 7, 9 and 12 stand rejected as indefinite under 35 USC §112;
3. Claims 1-5 and 7-12 stand rejected under 35 USC §102(b) as being anticipated by Published International Application No. WO 03/008756 (Bosma); and
4. Claim 6 stands rejected under 35 USC §103(a) as being unpatentable over Bosma in view of U.S. Patent No. 6,102,119 to Raines.

Regarding the objection to claim 5, please note that this claim has been amended above. The original claims 1-12 and new claims 13-20 were submitted with the application when filed, and many corrections (such as the dependency of claim 5) were made at that time to the claims. However, it appears that, due to this being a national stage application, the original 12 claims as amended in the PCT application are considered as the starting point for the claims. Therefore, the original 12 claims are amended above, and claims 13-20 are added above, so that they now conform to the claims in the specification as filed, with additional amendments as discussed below.

Regarding the indefiniteness rejections of claims 7, 9 and 12, please note that, as stated in MPEP §2173.05(b), “The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. ... Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” In the present case, a person of ordinary skill in the art would clearly understand what is meant by the term “substantially” in the rejected claims. In fact, the term “substantially” is given as an example in the MPEP of an acceptable relative term (see §2173.05(b), example D). Therefore, withdrawal of these rejections is respectfully requested.

Regarding the anticipation rejections based on the Bosma reference, please note that independent claim 1 has been amended above to recite that the castable material is disposed radially between the borehole and the device. Similarly, new independent claim 13 recites that the castable material is disposed radially between the expandable material and the borehole. Independent claim 8 has been amended above to recite that the castable material extends at least partially circumferentially about the annular element. These features are illustrated in FIGS. 1-4 and described in the specification.

In contrast, Bosma describes that the seal assemblies (e.g., elements 18, 20, 22) are longitudinally separated from the upper borehole section 1a in which cement 14 is disposed. The cement 14 is not disposed radially between an expandable annular element and a borehole, nor does the cement extend circumferentially about an expandable annular element. Therefore, Bosma cannot anticipate any of independent claims 1, 8 or 13, and withdrawal of the rejections of claims 1, 8 and their dependents is respectfully requested.

Regarding the obviousness rejection, due to the allowability of independent claim 1, its dependent claim 6 is also allowable. In addition, a *prima facie* case of obviousness

does not exist, because the references do not teach the limitations of claim 1 discussed above. Therefore, withdrawal of the rejection of claim 6 is respectfully requested.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-20 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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I hereby certify that this correspondence is being  
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